

REMARKS

Claims 1-15 are pending in the application.

Claims 1-15 have been rejected.

Various claims have been amended as set forth herein. Claims 1, 6, and 11 are amended to specify the relationship between the application data and the ratings, as described in the specification. Claim 1 is further amended as described below, and claims 6, 8, and 9 are amended to remove “means for” language. Claim 5, 10, and 15 are amended to describe an additional feature as supported in the specification.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 112

There are two separate requirements under 35 U.S.C. § 112, second paragraph. MPEP § 2171, p. 2100-209 (8th ed., rev. 5, August 2006). The first is subjective and requires that the claims must set forth the subject matter that the *Applicants* regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the scope of the claim is clear to one of ordinary skill in the art). *Id.* at 2100-210. The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id.* (*citing Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

Claims 1, 4, 6, 9, 11 and 14 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Examiner alleges that it is unclear how migration percentages are determined based on averaged assessment factor ratings.

The Examiner is again respectfully referred to the specification, e.g. at paragraphs 0028-0044, that describes how migration percentages are calculated, and how the assessment factor ratings include considerations of what is required onsite versus migrated, in an exemplary implementation. The Examiner includes specific questions regarding how migration percentages are determined. These processes, including an exemplary embodiment with a pseudo-code algorithm and reference table, are described in the specification.

With regard to this specific rejection, Applicants must respectfully note that the claims are clear and definite and serve their notice function as written. One of skill in the art is apprised of the claim scope, and can easily determine if he is performing each step of the claimed method. Absent some showing by the Examiner that the current broadly-claimed method is found in the prior art, Applicants are not required to limit the claimed method to the specific algorithms or tables described in the specification. The claim language is definite, which is the requirement under 35 U.S.C. § 112, second paragraph.

In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second

paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished), where the court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2. See also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004), which stated that "The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles. ...Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite."

Applicants respectfully notes that the Examiner's questions with regard the specific charts or guidelines used to perform the claimed method appear to be directed to an issue of *enablement*, not definiteness. The claims are only required to particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant, as broadly as possible in view of the prior art. The claims are not required to *enable* one of skill in the art to practice the invention – this is the purpose of the specification.

Claims 1, 4, 6, 9, 11 and 14 were also rejected under 35 U.S.C. § 112, second paragraph as allegedly “being incomplete for omitting essential steps, such omission amounting to a gap between the steps.”

First, Applicants respectfully notes that there are no missing steps that are essential to the claimed invention. The Examiner alleges that “[t]he omitted steps occur between the steps of averaging ratings and determining employee migration percentages.” This is simply not the case.

Further, by reference to MPEP 2172.01, the Examiner appears to be attempting to make a rejection under 35 U.S.C. § 112, *first* paragraph, not second paragraph. The relevant portion of this MPEP section describes:

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

The Examiner is respectfully requested to identify any omitted steps between the steps of averaging ratings and determining employee migration percentages that are “disclosed to be essential to the invention as described in the specification or in other statements of record.” Applicants respectfully submit that there are none.

The undersigned must admit that the basis of the Examiner’s concern is not understood, and respectfully invites the Examiner to telephone to resolve any remaining issues.

These rejections are traversed. Accordingly, the Applicants respectfully request the Examiner to withdraw the § 112 rejections.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §101:

Claims 1-5 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

In light of the current state of the still-evolving standards for statutory subject matter, claim 1 is amended above to specifically describe an interaction with and functions performed by a data processing system, as described in the specification. Of course, Applicants do not intend to surrender any patentable subject matter, and should the standards change again during the prosecution of this application, Applicants reserve the right to re-amend to capture as broad claim scope to which it may be entitled.

Accordingly, the Applicants respectfully request the Examiner to withdraw the double patenting rejection.

III. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0055697 to *Macken, JR. et al.*, hereinafter “Macken”. The Applicants respectfully traverse the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Absent such a *prima facie* case, the applicants are under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make

the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *Id.*

The independent claims require collecting application data. This is not taught by Macken.

The Examiner alleges this is taught at paragraph 0037, but is incorrect:

[0037] The customer's needs and processes are then be investigated in more detail. For example, a process migration "toolkit" (i.e., a set of tools adapted to facilitate process migration) may include a template associated with an initial questionnaire to be completed by the customer (e.g., a MICROSOFT® WORD template). Such a questionnaire might be used, for example, to understand a process and to estimate an amount of time that may be required at the first location to further investigate the process and/or to perform a migration. According to one embodiment, the questionnaire is automatically generated and/or transmitted to one or more customer employees (e.g., one section of the questionnaire may be transmitted to a human resources manager while another section is transmitted to a legal department). By way of example, the initial questionnaire could include some or all of the following sections: a contact list, a process description (e.g., including operations, measurements, control aspects and evolution), information technology aspects, human resources aspects, financial aspects, quality information, legal issues and customer expectations.

The "questionnaire" can include sections such as a process description (e.g., including operations, measurements, control aspects and evolution), information technology aspects, human resources aspects, financial aspects, quality information, legal issues and customer expectations, but is not taught to include application date.

. *Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

The independent claims require assigning ratings according to a plurality of assessment factors. Macken does mention a “scorecard” in which factors are rated.

The independent claims require averaging the ratings to determine an average rating. This is not taught by Macken. The Examiner alleges that this is taught at paragraph 0039, but is mistaken:

[0039] FIG. 4 is a process migration scorecard display 400 according to some embodiments of the present invention. As can be seen, the display 400 includes a feasibility scorecard and a risk assessment scorecard. Each scorecard includes a number of factors that are rated from "0" (difficult migration) to "5" (easy migration). For example, the complexity of the process is rated "2" indicating that some knowledge and/or ability will be required to perform the process. An overall score is then computed based on these ratings, and the overall score is used to determine whether the process should be migrated. According to one embodiment, certain ratings result in pre-determined actions. For example, a rating below "3" may trigger generation of a risk mitigation action plan.

It is clear that while an “overall score” is indicated, there is no teaching at all in Macken of determining an average rating or that the “overall score” is an average of anything.

The independent claims also require determining employee migration percentages according to the average rating. This is not taught by Macken, although the Examiner incorrectly alleges it is taught at paragraph 0041:

[0041] Information associated with Full Time Employee (FTE) values (e.g., fifty employees from January through September and sixty employees from October through December) and ramp-up plans for the second location may also be determined via a process migration toolkit template. Prior customer staffing plans (i.e., historical information) can also be used to determine appropriate FTE values. According to one embodiment, information in a FTE plan is automatically used to generate requisitions, such as human resources,

technology and/or telecommunication requisitions. For example, a human resources requisition form may be generated and used to initiate hiring of new employees needed for the process. The human resources requisition may also indicate the appropriate skills that are required for those employees (e.g., UNIX.RTM. and database administrator skills).

It is clear that this “information” is not taught to include migration percentages, and is not taught to correspond to any average rating.

The Examiner’s response appears to indicate that the Examiner believes the only distinction is “in the substitution of the averaging of score for the sum of scores.” This is incorrect. Macken also does not have any employee migration percentages at all. Macken mentions that there can be an “FTE value” as a baseline parameter, but no employee migration percentages. Macken’s “FTE value” is not taught or suggested to be based at all on Macken’s “scores”, whether summed or averaged, as required by the claims.

Applicants must therefore respectfully note that the Examiner’s analysis is simply incorrect. No art of record teaches or suggests the advisability, predictability, or possibility of determining employee migration percentages according to the average rating, as claimed.

As amended, the independent claims also require that the application data is collected and stored as a plurality of entries in an application inventory. This is also not taught or suggested by Macken.

As Macken fails to teach multiple limitations of the independent claims, all rejections are traversed.

Accordingly, the Applicants respectfully request the Examiner to withdraw the § 103 rejection with respect to these claims.

CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

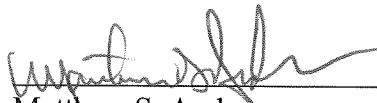
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

MUNCK CARTER P.C.

Date: 10/1/9


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